

REMARKS

Claim 11 has been amended in order to more particularly point out, and distinctly claim the subject matter to which the applicants regard as their invention. The applicants respectfully submit that no new matter has been added. It is believed that this Amendment is fully responsive to the Office Action dated **March 17, 2004**.

Claim Objections

Claim 11 was objected to because of an informality.

Claim 11 has been amended to delete the period “.” after “magnet” and insert a comma. This objection has not been rendered moot.

Claim Rejections under 35 USC §112

Claims 11-13 are rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding this rejection the Examiner was telephoned by the Applicant’s representative to inquire about the basis for the rejection. The Examiner left a voice mail message explaining that claim 11 is directed to an article or product (i.e., the magnet) but recites steps of a process, and he believes that this is indefinite. The Applicant’s representative wishes to thank the Examiner for his assistance.

The Examiner’s rejection is respectfully traversed. A claim to an article, that recites a process for

making the article, is recognized under U.S. patent practice as a "product-by-process" claim. Such claims are authorized by the examiners' manual: MPEP § 2173.05(p) states that "a product claim that defines the claimed product in terms of the process by which it is made, is proper" (case law is cited), and this section then adds that a product-by-process claim should not be rejected under § 112, second paragraph, unless it is unclear whether the claim is directed to the product or to the process. The Applicants' claim 11 recites "A ... magnet... which is produced by a process of..." and the Applicant believes that this clearly is directed to the magnet and not to the process. Therefore, withdrawal of the rejection of Claims 11-13 under 35 USC §112, second paragraph, is respectfully requested.

Claim Rejections under 35 USC §103

Claims 11-17 are rejected under 35 USC §103(a) as being unpatentable over Koike et al. (JP 411003811A) in view of Ribitch (U.S. Patent No. 5,360,527).

Ribitch is cited and is applied for disclosing electroplating of magnets, at col. 1, lines 24-39. The Examiner asserts that this disclosure of electroplating is a disclosure of "coating a fine metal powder on a magnet" (Office Action at page 3, third paragraph). The applicant disagrees with the Examiner because Ribitch appears to disclose only conventional electroplating (col. 1, lines 9-23), which does *not* produce powder, and Ribitch teaches that the electroplating preferably produces "a uniform thickness coating" (col. 1, line 41), so the applicant believes that there is teaching against powdery or granular coatings.

The Examiner may be relying on the disclosure of "organic powder" at col. 1, line 34, but if so then the rejection is in error, because organic powder is not used in electroplating. Ribitch is clearly referring to an alternate, non-metallic process.

Further, there is no description about metal powder in Ribitch, so the magnet of the present invention cannot be deduced from a combination with Koike. The magnet described in Yamamoto is a ferrite magnet having no problem in corrosion, which is different from the rare earth metal-based permanent magnet of the present invention, so that such a technical task as imparting corrosion resistance does not exist in this reference. Therefore, there is no motivation to combine Yamamoto with Koike or Ribitch. Even if it is possible to combine them, the magnet of the present invention cannot be deduced from the combination.

Therefore, withdrawal of the rejection of Claims 11-17 under 35 USC §103(a) as being unpatentable over Koike et al. (JP 411003811A) in view of Ribitch (U.S. Patent No. 5,360,527) is respectfully requested.

Claims 12, 13/12, 15 and 17 are rejected under 35 U.S.C. §103 as being unpatentable over Koike as applied to claims 11 and 14, and further in view of Yamamoto (U.S. Patent 5,649,362).

The Examiner now asserts that Yamamoto discloses a magnet (not a magnet hole) with the claimed ratio. As discussed above, this new rejection appears to be incorrect because Ribitch discloses no powder. Therefore, claims 12, 13/12, 15 and 17 are allowable by virtue of their dependence upon allowable independent claims. Therefore, withdrawal of the rejection of Claims 12, 13/12, 15 and 17 under 35 U.S.C. §103 as being unpatentable over Koike as applied to claims 11 and 14, and further in view of Yamamoto.

Conclusion

In view of the aforementioned amendments and accompanying remarks, claim 11, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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